

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

ORACLE INTERNATIONAL CORP,

No C 03-2267 VRW

Plaintiffs,

ORDER

v

MANGOSOFT, INC, et al

Defendants.

On March 30, 2005, the court held a claim construction hearing pursuant to Markman v Westview Instruments, Inc, 517 US 370 (1996). Based on the parties' arguments at the hearing and their submissions to the court, the court issues the following claim construction order.

There is one patent-in-suit, relating to inventions in the field of networked computer systems, and more specifically to interrupting page delivery operations in a web environment. As the court writes principally for the parties, it will not discuss the details of the inventions or define terms well-known to those

1 skilled in the art, except as is necessary to construe the claims  
2 of the patents.

3  
4 I

5 United States Patent No 6,317,790 B1 (the "'790 patent"),  
6 granted to Michael Bowker, et al, on November 13, 2001, discloses  
7 "[a] system, method, and computer readable-medium for interrupting  
8 client requests in a web environment." '790 patent, Abstract. The  
9 system includes "a server, such as a web server, for receiving a  
10 request from a particular client," but "[r]ather than directly  
11 supplying the requested information, the server determines whether  
12 unrequested operations should be performed," and if so, the server  
13 performs the operations before returning the the information  
14 requested by the client. Id.

15 II

16 The construction of patent claims is a question of law to  
17 be determined by the court. Markman, 517 US at 372. The goal of  
18 claim construction is "to interpret what the patentee meant by a  
19 particular term or phrase in a claim." Renishaw PLC v Marposs SpA,  
20 158 F3d 1243, 1249 (Fed Cir 1998). In determining what a patentee  
21 meant by a term or phrase, the court looks first to the claim  
22 itself.

23 The claims of the patent provide the concise formal  
24 definition of the invention. They are the numbered  
25 paragraphs which "particularly [point] out and distinctly  
26 [claim] the subject matter which the applicant regards as  
27 his invention." 35 USC § 112. It is to these wordings  
28 that one must look to determine whether there has been  
infringement. Courts can neither broaden nor narrow the  
claims to give the patentee something different than what  
he has set forth. No matter how great the temptations of  
fairness or policy making, courts do not rework claims.  
They only interpret them.

1 EI Du Pont de Nemours & Co v Phillips Petroleum Co, 849 F2d 1430,  
2 1433 (Fed Cir 1988).

3 "The claims define the scope of the right to exclude; the  
4 claim construction inquiry, therefore, begins and ends in all cases  
5 with the actual words of the claim." Renishaw, 158 F3d at 1248.

6 "The words used in the claim are viewed through the viewing glass  
7 of a person skilled in the art." Brookhill-Wilk 1, LLC v Intuitive  
8 Surgical, Inc, 326 F3d 1215, 1220 (Fed Cir 2003) (citing Tegal Corp  
9 v Tokyo Electron Am, Inc, 257 F3d 1331, 1342 (Fed Cir 2001)).

10 "Absent a special and particular definition created by the patent  
11 applicant, terms in a claim are to be given their ordinary and  
12 accustomed meaning." York Prods, Inc v Central Tractor Farm &  
13 Family Ctr, 99 F3d 1568, 1572 (Fed Cir 1996). The court may, if  
14 necessary, consult a variety of sources to determine the ordinary  
15 and customary meaning of a claim term, including the claim terms  
16 themselves, dictionaries, the written description, the drawings and  
17 the prosecution history, if in evidence. Brookhill-Wilk 1, 326 F3d  
18 at 1220. "Such intrinsic evidence is the most significant source  
19 of legally operative meaning of disputed claim language."

20 Vitronics Corp v Conceptronic, Inc, 90 F3d 1576, 1582 (Fed Cir  
21 1996). With respect to dictionary definitions, "[i]f more than one  
22 dictionary definition is consistent with the use of the words in  
23 the intrinsic record, the claim terms may be construed to encompass  
24 all such consistent meanings." Texas Digital Systems, Inc v  
25 Telegenix, Inc, 308 F3d 1193, 1203 (Fed Cir 2002).

26 The court begins its construction of claim terms by  
27 consulting intrinsic evidence of the meaning of disputed claim  
28 terms, which includes the claims, the specification and the

1 prosecution history (if in evidence). Lacks Industries, Inc v  
2 McKechnie Vehicle Components USA, Inc, 322 F3d 1335, 1341 (Fed Cir  
3 2003) (citation omitted). "If upon examination of this intrinsic  
4 evidence the meaning of the claim language is sufficiently clear,  
5 resort to 'extrinsic' evidence, such as treatises and technical  
6 references, as well as expert testimony when appropriate, should  
7 not be necessary." Digital Biometrics, Inc, v Identix, Inc, 149  
8 F3d 1335, 1344 (Fed Cir 1998). "[I]f after consideration of the  
9 intrinsic evidence, there remains doubt as to the exact meaning of  
10 the claim terms, consideration of extrinsic evidence may be  
11 necessary to determine the proper construction." *Id.*

12 "[A] court may constrict the ordinary meaning of a claim  
13 term in \* \* \* one of four ways[:]" (1) "if the patentee acted as  
14 his own lexicographer and clearly set forth a definition of the  
15 disputed claim in either the specification or prosecution history;"  
16 (2) if the intrinsic evidence shows that the patentee distinguished  
17 the term from prior art on the basis of a particular embodiment,  
18 expressly disclaimed subject matter, or described a particular  
19 embodiment as important to the invention; (3) "if the term chosen  
20 by the patentee so deprives the claim of clarity as to require  
21 resort to other intrinsic evidence for a definite meaning; and (4)  
22 "if the patentee phrased the claim in step- or means-plus-function  
23 format," then "a claim term will cover nothing more than the  
24 corresponding structure or step disclosed in the specification, as  
25 well as equivalents thereto \* \* \*." CCS Fitness, Inc v Brunswick  
26 Corp, 288 F3d 1359, 1366-67 (Fed Cir 2002) (internal citations and  
27 quotation marks omitted).

28 Limitations from the specification, such as from the

1 preferred embodiment, cannot be read into the claims absent an  
2 express intention to do so. Teleflex, Inc v Ficosa North Am Corp,  
3 299 F3d 1313, 1326 (Fed Cir 2002) ("The claims must be read in view  
4 of the specification, but limitations from the specification are  
5 not to be read into the claims."). But "a construction that  
6 excludes a preferred embodiment 'is rarely, if ever, correct.'"  
7 C R Bard, Inc v United States Surgical Corp, 388 F3d 858, 865 (Fed  
8 Cir 2004) (citing Vitronics, 90 F3d at 1583).

9 With these legal principles in mind, the court now turns  
10 to the construction of the disputed claim language of the patent-  
11 in-suit.

### 12 III

13  
14 The parties parse the elements of '790 claims similarly,  
15 and only request the court to construe seven terms. Claim 1 of the  
16 patent is illustrative:

17  
18 1. A method for server interruption of user  
19 requests, the method comprising the steps of:

20 a server receiving a request from a user for a  
21 particular set of information, wherein  
22 preparation and delivery of said particular set  
of information requires a particular series of  
operations;

23 in response to said request, said server  
collecting supplemental information about said  
24 user from a server-side storage unit; and

25 Said server determining, based on said  
supplemental information, whether to perform  
26 one or more operations prior to supplying said  
particular set of information to said user,  
27 wherein said one or more operations do not  
alter any operation in said particular series  
28 of operations;

1 if said server determines that said one or more  
2 operations should be performed, then performing  
3 said one or more operations prior to supplying  
4 said particular set of information to said  
5 user, and

6 after performing said one or more operations,  
7 said server replying to said user with said  
8 particular set of information; and

9 if said server determines not to perform said  
10 one or more operations, then replying to said  
11 user with said particular set of information.

12 1. a server

13 Plaintiff proposes that this term be construed as  
14 "hardware and software that provide resources to a client." Doc  
15 #33 at 6-11; Doc #37 at 2-3. Defendants propose "a computer that  
16 provides network resources to a client." Doc #36 at 7-8.  
17 Plaintiffs argue that "a computer" is unclear and vague, so  
18 "hardware and software" is more precise. But the written  
19 description of the patent directly contradicts plaintiff's  
20 argument:

21 In alternative embodiments, hard-wired  
22 circuitry may be used in place of or in  
23 combination with software instructions to  
24 implement the invention. Thus, embodiments of  
25 the invention are not limited to any specific  
26 combination of hardware circuitry and software.

27 '790 patent, 3:48-54. Plaintiff's proposed construction does limit  
28 the invention to a specific combination of hardware circuitry and  
29 software, namely one where software is not replaced by hard-wired  
30 circuitry as contemplated and disclosed in the specification.  
31 "[T]he specification is always highly relevant to the claim  
32 construction analysis. Usually, it is dispositive; it is the single  
33 best guide to the meaning of a disputed term." Vitrionics, 90 F3d

1 1576.

2           Although it is true that the written description is not a  
3 substitute for the claim language, this is not the case where an  
4 unclaimed limitation from the specification is being imported into  
5 and substituted for the claim language. Superguide Corp v  
6 DirectTV, 358 F3d 870, 875 (Fed Cir 2004). Here, the specification  
7 expressly states that the invention should not be limited to any  
8 particular combination of hardware and/or software, which disclaims  
9 the limitation of the invention to "hardware and software" and  
10 thus, the court may not adopt plaintiff's proposed construction.

11           Despite rejecting plaintiff's proposal, the court may not  
12 simply adopt defendant's proposal carte blanche. Plaintiffs argued  
13 that "a computer" may limit servers to embodiments made of only a  
14 single computer, while it is well-known in the art that a cluster  
15 of multiple computers or multiple computer components may function  
16 as a server. Accordingly, the court modifies defendant's proposal  
17 to change "a computer" to "a computer system."

18           Defendants also propose that the term "network resources"  
19 be added to the construction of the term "server." But there is no  
20 mention of a network in claim 1. While defendant presented a  
21 dictionary definition in support of limiting servers to those that  
22 provide network resources, plaintiff pointed to a dictionary  
23 definition consistent with the idea that a server need not interact  
24 with network resources. "If more than one dictionary definition is  
25 consistent with the use of the words in the intrinsic record, the  
26 claim terms may be construed to encompass all such consistent  
27 meanings." Texas Digital Systems, 308 F3d at 1203. Clearly, a  
28 server that provides resources may also provide network resources,

1 so the court should construe this term so that both definitions are  
2 encompassed.

3 Accordingly, the court construes "server" as "a computer  
4 system programmed to provide resources to a client."

5  
6 2. request from a user

7 Defendants propose that this term be construed as "a  
8 request initiated by a person using a computer." Doc #36 at 13-15.  
9 Plaintiff asserts that there is no need to construe this term. The  
10 "user" is defined in the specification as "[having] a list of  
11 favorite activities and interests," '079 patent, 8:67-9:1.  
12 Additionally, the specification notes that it "may be desirable to  
13 have the user view the advertisement as long as possible." 9:65-66.  
14 Furthermore, at the claim construction hearing, Plaintiff's own  
15 expert declared that one of ordinary skill in the art would  
16 understand a "user" in this limitation to be person, and not  
17 software. Accordingly, the court adopts defendants' proposal and  
18 construes "request from a user" as "a request initiated by a person  
19 using a computer."  
20

21 3. particular set of information

22 Defendants' proposal limits "a particular set of  
23 information" to "a web page." Doc #36 at 13-15. Plaintiff alleges  
24 that there is no need to construe this term. "Absent a special and  
25 particular definition created by the patent applicant, terms in a  
26 claim are to be given their ordinary and accustomed meaning." York  
27 Prods, Inc v Central Tractor Farm & Family Ctr, 99 F3d 1568, 1572  
28 (Fed Cir 1996). The plain meaning of "a particular set of



1 information" is not limited to "a web page." Accordingly, the  
2 court construes this term according to its plain meaning.

3  
4 4. server-side

5 While plaintiff proposes that there is no need to  
6 construe this term, defendants argue that it should be construed as  
7 "occurring on the server side of a network connection extending  
8 between a client and a server." Doc #33 at 23-34; Doc #37 at 10-  
9 11; Doc #36 at 15. Defendants' proposed construction is circular -  
10 - it uses the words "server side" in combination with additional  
11 unclaimed limitations to define the term "server-side." This, they  
12 cannot do, for two reasons. First, "server" was submitted for  
13 construction on its own and the addition of "-side" to any well-  
14 understood term is within the realm of plain meaning. Second, even  
15 if some embodiments disclose the invention as function via a  
16 network connection, the court may not import the unclaimed  
17 limitation of "a network connection extending between a client and a  
18 server" into the claim. EI Du Pont de Nemours, 849 F2d at 1433  
19 (Fed Cir 1988). Accordingly, the court construes this claim  
20 according to its plain meaning in light of the construction of the  
21 term "server."

22  
23 5. client

24 Plaintiffs propose that a "client," which first appears  
25 in claim 6 of the '079 patent, should be construed as "hardware and  
26 software that accesses resources provided by a server." Doc #33 at  
27 11; Doc #37 at 4. Defendants propose "a computer that accesses  
28 network resources provided by a server." Doc #36 at 4. These

1 proposed constructions present the same challenges as the  
2 constructions proposed for "server," namely, whether "a computer"  
3 and "network resources" are appropriately included in the  
4 construction. Accordingly, in keeping with the analysis above for  
5 the term "server," the court construes "client" to be "a computer  
6 system programmed to access resources provided by a server."

7  
8 6. web server

9           Plaintiff's proposal construes this term, which first  
10 appears in claim 48, as "any processor which transmits data  
11 objects, applications or files to a requestor via Web protocols."  
12 Doc #33 at 16-18; Doc #37 at 6-7. Defendants argue for a more  
13 limiting construction: "A server that transmits requested  
14 information to a client using the Hypertext Transfer Protocol  
15 (HTTP)." Doc #36 at 11-13. The parties' constructions diverge on  
16 two main points: (1) what is a server in the context of a web  
17 server and (2) what protocol or protocols must a web server  
18 utilize?

19           For the first issue, plaintiffs attempt to extend the  
20 definition of server to include "any processor." Doc #33 at 16.  
21 Plaintiffs, however, present no intrinsic or extrinsic evidence in  
22 support of this construction. Accordingly, the court's  
23 construction of web server will use the term "server" in accordance  
24 with its construction of "a computer system programmed to provide  
25 resources to a client."

26           The parties' disagreement over the second issue  
27 (protocols) is more difficult. Plaintiffs propose that a web  
28 server transmits information via "Web protocols," while defendants'

1 proposal requires that a web server transmits information via HTTP.  
2 At oral argument, both parties agreed that HTTP was a Web protocol,  
3 and plaintiff's counsel further agreed that HTTP is the "typical"  
4 web protocol used by web servers. Plaintiff argued, however, that  
5 limiting a web server to using HTTP is unreasonable because one  
6 skilled in the art would know that a web server can use Web  
7 protocols other than HTTP. Plaintiff pointed to the deposition of  
8 defendant's expert to support the notion that a web server could  
9 transmit information via Web protocols other than HTTP, such as  
10 file transfer protocol ("FTP"), etc. Pl slides at 53. However, in  
11 the same discussion, defendants' expert made clear that all web  
12 servers of which he was aware used HTTP. Gray Depo at 105:18-25.  
13 In contrast, defendants relied upon intrinsic evidence in the  
14 specification and dictionary definitions in support of their  
15 argument that at a minimum a web server must use HTTP. Def slides  
16 at 20-24.

17           Contrary to plaintiff's argument, limiting the  
18 construction of a web server to those that transmit information via  
19 HTTP does not preclude web servers which transmit information via  
20 other Web protocols such as FTP. The claims at issue in the '079  
21 patent are "open," because the preamble in each claim uses the word  
22 "comprising." Stiftung v Renishaw PLC, 945 F.2d 1173, 1178 (Fed  
23 Cir 1991). Open claims read upon any method or product that meets  
24 each element of the claims, regardless whether the accused method  
25 or product includes extra elements that are not claimed. *Id.*  
26 Accordingly, a construction of web server requiring transmission of  
27 information via HTTP merely means that in order to be a web server,  
28 the server must utilize the typical web protocol of HTTP. Thus,

1 web servers that utilize additional web protocols other than HTTP  
2 are not precluded by defendant's proposed construction.  
3 Accordingly, the court adopts defendants' construction of "web  
4 server" as "a server that transmits requested information to a  
5 client using the Hypertext Transport Protocol (HTTP)."

6  
7 7. web browser(s)

8 Plaintiff proposes that this term, which first appears in  
9 claim 48 of the '079 patent, should be construed as, "programs used  
10 to request, decode and display information sent over the World Wide  
11 Web." Doc #33 at 13-15; Doc #37 at 5. Defendants argue that it  
12 should be construed as, "client applications that enable users to  
13 request, decode and display HTML documents." Doc #36 at 10-11.

14 Defendants rely upon intrinsic evidence from the  
15 specification of the '079 patent and dictionary definitions to show  
16 that a web browser must be capable of requesting, decoding and  
17 displaying HTML documents. Def slides at 27. In contrast,  
18 plaintiffs rely upon extrinsic evidence in the form of expert  
19 declaration and testimony to show that a browser need not be  
20 limited to requesting, decoding and displaying HTML documents. Pl  
21 slides at 59-60.

22 Although extrinsic evidence is inherently less  
23 instructive on issues of claim construction than intrinsic  
24 evidence, in this instance the court need not disregard plaintiff's  
25 extrinsic evidence in construing the term. As discussed above with  
26 respect to "web server," the claims at issue in this patent are  
27 "open" claims, and as such, claim constructions read upon all  
28 embodiments that meet each claim element, regardless of extra

1 features. Stiftung, 945 F.2d 1173, 1178 (Fed Cir 1991).

2 Thus, defendant's proposed construction does not preclude  
3 a web browser from "using the ftp protocol to access text files,"  
4 Gray Depo at 106:12-16, as long as the web browser also allows a  
5 user to "request, decode and display HTML documents." Basically,  
6 defendant's proposed construction requires that at a minimum, a web  
7 browser must be capable of browsing the World Wide Web, which  
8 requires that the web browser be capable of requesting, decoding,  
9 and displaying HTML documents. Accordingly, the court adopts  
10 defendants' construction and construes "web browsers" as "client  
11 applications enabling users to request, decode and display HTML  
12 documents."

13 The parties are ORDERED to attend a case management  
14 conference (CMC) on June 21, 2005, at 9:00 am or on another such  
15 date that the parties may arrange with each other and the court's  
16 deputy, Cora Delfin, who may be reached at (415) 522-2039. The  
17 parties' joint CMC statement should include a proposed schedule for  
18 dispositive motions.

19  
20 IT IS SO ORDERED.

21  
22 

23 VAUGHN R WALKER  
24 United States District Chief Judge  
25  
26  
27  
28